

**REMARKS**

**I. Status of the Claims**

Claims 1-67 are pending in this application. Claims 1 and 2 have been amended. Support for the amendments can be found in the original specification and claims, e.g., at page 21, lines 2-6, of the specification. No new matter has been introduced by these amendments, nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Office.

**II. Rejections Under 35 U.S.C. § 102(b)**

The Examiner has rejected claims 1, 2, 10, and 11 as anticipated by European Patent Nos. EP 0 374 332 ("332") and EP 0 331 833 ("EP '833"), and claims 1-11 as anticipated by European Patent No. EP 0 819 426 ("EP '426") under 35 U.S.C. § 102(b) for the reasons set forth on pages 2-5 of the present Office Action. Applicants respectfully traverse this rejection for at least the reasons set forth below.

Anticipation requires that a reference "clearly and unequivocally disclose the claimed compound." *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). Not one of the references cited satisfies this standard.

In a previous Office Action, the Examiner stated that "[t]he claims now rejected [claims 1, 2, 10, and 11] are not limited to the instantly claimed viscosity." (Office Action dated January 17, 2001, page 5, lines 3-5.) Applicants, however, in this Reply have amended claims 1 and 2 by incorporating a viscosity limitation that is not disclosed in any of the references cited by the Examiner. Specifically, as amended, claims 1 and 2

recite "wherein said emulsion has a dynamic viscosity ranging from 100 mPa.s to 20 Pa.s, this viscosity being measured on a Rheomat 180 from Mettler using a Spindle No. 2 at 25°C, at a shear rate of 200s<sup>-1</sup>, and at time t=10 minutes." The references cited do not teach, let alone teach clearly and unequivocally, *at least* Applicants' claimed viscosity.

Additionally, the Examiner attempts to show anticipation by pointing out that "EP '833 discloses at page 3, lines 37-39 that the compositions of the prior art exhibit flexibility." (Office Action dated June 4, 2001, page 6, lines 4-5.) And further that "the disclosure of flexibility of the composition is considered to encompass improved staying power and reduced or eliminated transfer or migration." (Office Action dated June 4, 2001, page 6, lines 7-8.) This disclosure in EP '833, however, when read in its entirety, makes it clear that the oil component of the reference is responsible for the flexibility of the compositions—not the polyoxyalkylene modified organopolysiloxanes. Thus, the term "flexibility" used in the reference, contrary to the Examiner's assertion, is not the same as staying power, reduced transfer, or even reduced migration. For example, the text of the reference provides:

since the outer phase consists of an **oil component**, the advantages of skin protection, **flexibility**, etc., can be obtained in the fields of cosmetics and pharmaceuticals, although the **drawbacks of stickiness** during usage and a high skin barrier also exist.

(EP '426, page 3, lines 37-40 (emphasis supplied).)

The reference does not discuss staying power, reduced transfer, or reduced migration. Accordingly, Applicants respectfully submit that it is error to read these terms into the reference to support an anticipation rejection. In fact, Applicants disclose the

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terms "softness" and "fluidity" with respect to silicone oil content. (Specification, page 1, lines 15-17.) Thus, the term "flexibility" is better equated with these terms.

With respect to '332, the disclosure pointed to by the Examiner refers to a "solid cosmetic composition." ('332, page 5, line 43.) Applicants claims 1 and 2, particularly with the viscosity limitation, do not encompass solids.

Further, the Examiner has not pointed to any disclosure in *EP* '426 to show that staying power, reduced transfer, or reduced migration are present in that reference either.

Accordingly, Applicants respectfully request that all of the rejections under § 102(b) be withdrawn, as the Examiner has not satisfied her burden under § 102(b) for any of the three rejections.

### **III. Rejections Under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1-23, 25, 27-37, 39-60 and 62-66 under 35 U.S.C. § 103(a) as obvious over European Patent No. 0 819 426 A2 ("*EP* '426") in combination with U.S. Patent No. 5,593,680 ("*US* '680"). (Office Action dated June 4, 2001, pages 8-10.) Applicants respectfully traverse this rejection for at least the reasons below in addition to the reasons of record. Further, it appears that the rejection of claims 1-19, 23-60, and 62-67 under 35 U.S.C. § 103(a) as obvious over *EP* '426 in combination with European Patent No. 0 331 833 A1, set forth in the Office Action dated January 17, 2001, pages 5-6, has been withdrawn. Applicants respectfully request clarification of the status of this rejection. If this rejection has not been withdrawn, Applicants continue to traverse it for the reasons of record.

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To establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing *at least* that the prior art references teach or suggest all of the elements of the claimed invention. M.P.E.P. § 2143 (emphasis supplied). In the present case, the Examiner has not cited a reference, nor a reference combination, that teaches or suggests all of the claimed invention's elements.

Clearly, *EP '426*, as discussed above, does not teach or suggest all of the claimed invention's elements, as the *MPEP* requires. This reference does not teach or suggest improved staying power, reduced or eliminated transfer or migration, or, as discussed, Applicants' claimed viscosity. (Claims 1 and 2.) To satisfy her burden under § 103, the Examiner must provide specific factual or technical grounds to establish that the allegedly inherent properties are necessarily present in the compositions of the references cited. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (holding that inherency must be a necessary conclusion of the prior art, not simply a possible one).

Further, to reach present claim 12, one would have to select from *EP '426* the  $\alpha,\omega$ -substituted oxyalkylenated silicone, wherein  $R^1$  is a methyl group,  $n$  is equal to 100, the average molecular weight of  $R$  ranges from 800 to 1000, and obtain an emulsion with Applicants' claimed viscosity. *EP '426*, however, leads one away from Applicants' claim 12 by disclosing that the "especially preferred" silicones are those where  $R^1$  is hydrogen. (*EP '426*, line 24.) Further, the examples provided by *EP '426* disclose only one silicone where  $R^1$  is a methyl group. (*EP '426*, Table on page 6.) Even further, this particular example, emulsifier 5, discloses a mean desired molecular weight of the  $R$  group as 2,550, which falls outside of Applicants' claimed range. Accordingly,

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Applicants submit that selecting the  $\alpha,\omega$ -substituted oxyalkylenated silicone of claim 12 from *EP* '426 would require picking and choosing with the aid of hindsight as guidance, which is improper, as the Examiner knows. At most, the *EP* '426 reference may have provided a starting point for experimentation, but this is insufficient to render Applicants' claim 12 obvious.

Thus, *EP* '426, as discussed above and as evidenced by the Examiner's statements, is insufficient standing alone. The Examiner has admitted on the record that "EP '426 does not teach ... claims 15-22 ... claim 24 ... claim 26 ... claims 31, 33 ... claim 38 ... claim 41 ... or claims 51-54." (Office Action dated January 17, 2001, page 6, lines 12-17.) *US* '680 cannot be relied upon to remedy the deficiencies of *EP* '426. Specifically, there is no motivation to combine the two references. The Examiner states that she did not intend such a combination, contending that "US '680 is used merely to show that the dyes of instant claim 20 are known for use in cosmetic compositions." (Office Action dated June 4, 2001, page 9, lines 14-16.) Applicants note that dyes are recited only in present claims 15-22, not in all of the rejected claims. Thus, if *US* '680 is used only for the purpose enunciated by the Examiner, the rejection of claims 1-23, 25, 27-37, 39-60 and 62-66 is unsupported. Accordingly, Applicants submit that rejection of this entire group of claims over *EP* '426 is improper, because the reference fails to teach the claimed subject matter and the secondary reference (*US* '680) cited by the Examiner fails to cure the primary reference's deficiencies.

As the Examiner has not demonstrated that all of Applicants' claim elements are taught or suggested by the *EP* '426 reference or any combination of references therewith, the Examiner's determination of obviousness is improper. Accordingly,

Applicants respectfully submit that this rejection under § 103 should therefore be withdrawn.

**IV. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 26, 2001

By: 

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Attachment: Appendix to Amendment

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APPENDIX TO AMENDMENT OF September 26, 2001

Version with Markings to Show Changes Made

IN THE CLAIMS:

1. (Twice amended) A process comprising introducing into a cosmetic, hygiene or pharmaceutical composition an emulsion comprising at least one  $\alpha,\omega$ -substituted oxyalkylenated silicone in an amount effective for reducing or eliminating the transfer or migration of said composition when put to use, wherein said emulsion has a dynamic viscosity ranging from 100 mPa.s to 20 Pa.s, this viscosity being measured on a Rheomat 180 from Mettler using a Spindle No. 2 at 25°C, at a shear rate of 200s<sup>-1</sup>, and at time t=10 minutes.
  
2. (Twice amended) A process comprising introducing into a cosmetic, hygiene or pharmaceutical composition an emulsion comprising at least one  $\alpha,\omega$ -substituted oxyalkylenated silicone in an amount effective for improving the staying power of said composition when put to use, wherein said emulsion has a dynamic viscosity ranging from 100 mPa.s to 20 Pa.s, this viscosity being measured on a Rheomat 180 from Mettler using a Spindle No. 2 at 25°C, at a shear rate of 200s<sup>-1</sup>, and at time t=10 minutes.

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